

Notice of Allowability

Application No.

09/747,287

Examiner

Chih-Min Kam

Applicant(s)

PACKARD ET AL.

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 8/9/04.
2. ☒ The allowed claim(s) is/are 32,35-47 and 103-106.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☒ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☒ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☒ to Paper No./Mail Date 0204.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date <u>20041020</u> . |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date <u>4/7/03</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

Art Unit: 1653

An **Examiner's Amendment** to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Tom Hunter on October 21, 2004.

Examiner's Amendments to the Specification:

Please replace the paragraph at page 1, lines 5-11 with the following paragraph:

This is a continuation-in-part of USN 09/394,019; filed on September 10, 1999, which is a continuation-in-part of USSN 08/802,981, filed on February 20, 1997, now U. S. Patent 6,037,137. This is also a continuation-in-part of PCT/US00/24882, filed on September 11, 2000 designating the United States, which is a continuation-in-part of USN 09/394,019, filed on September 10, 1999, which is a continuation-in-part of USSN 08/802,981, filed on February 20, 1997, now U. S. Patent 6,037,137. All of these documents are herein incorporated by reference in their entirety for all purposes.

Please replaced the term "Table 11" with "Table 5" at page 63, line 3; page 64, line 5; page 64, line 13; and page 65, line 6.

Please replaced the term "Table 12" with "Table 6" at page 65, line 31; page 66, line 6; page 69, line 9; page 69, line 23; page 70, line 10; page 71, line 32; and page 73, line 3.

Examiner's Amendments to the Claims:

Claim 32, 35 and 39 have been amended, and new claims 105 and 106 have been added as follows:

Claim 32 (Currently amended): A mammalian cell comprising a fluorogenic composition comprising a polypeptide backbone joining two identical fluorophores [of the same species] whereby said fluorophores form an H-dimer resulting in the quenching of the fluorescence of said fluorophores.

Art Unit: 1653

Claim 35 (Currently amended): The cell of claims 32, [or] 103, 105 or 106, wherein said composition bears a hydrophobic group.

Claim 39 (Currently amended): The cell of claim 35, wherein said hydrophobic group is attached to an amino terminus of the [molecule] polypeptide.

Claim 105 (New): A mammalian cell comprising a fluorogenic composition comprising a polypeptide backbone joining two fluorophores of the same species, wherein said fluorophores are xanthenes, whereby said fluorophores form an H-dimer resulting in the quenching of the fluorescence of said fluorophores.

Claim 106 (New): A mammalian cell comprising a fluorogenic composition comprising a polypeptide backbone joining two fluorophores of the same species, wherein said fluorophores are carbocyanine dyes, whereby said fluorophores form an H-dimer resulting in the quenching of the fluorescence of said fluorophores.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached at 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/747,287

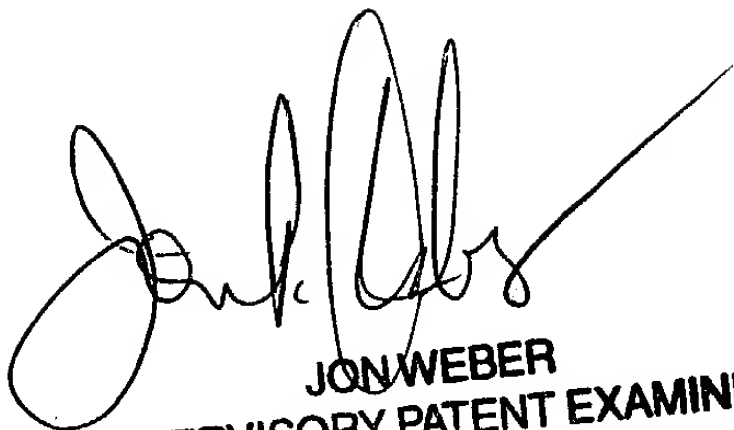
Page 4

Art Unit: 1653

Chih-Min Kam, Ph. D.
Patent Examiner

CMK

CMK
October 22, 2004



JON WEBER
SUPERVISORY PATENT EXAMINER